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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,959	07/30/2003	David J. Trettin	5658/934	8892
757	7590	07/28/2004	EXAMINER	
BRINKS HOFER GILSON & LIONE			HOWELL, DANIEL W	
P.O. BOX 10395			ART UNIT	PAPER NUMBER
CHICAGO, IL 60610			3722	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/629,959	<b>Applicant(s)</b> TRETTIN ET AL.	
	<b>Examiner</b> Daniel W. Howell	<b>Art Unit</b> 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 64-90 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 64-90 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7-12-04</u> . | 6) <input type="checkbox"/> Other: ____.  |

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1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 64-90 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Each independent and some dependent claims of the amendment filed March 8, 2004, sets forth a "non-threaded positioning member." The specification as originally filed makes absolutely no mention of a "non-threaded" positioning member. The specification as originally filed makes no comment on whether the positioning member must be threaded or non-threaded. The addition of this term "non-threaded" to the claims constitutes new matter.

3. Claims 64-90 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The amendment of March 8, 2004, has included the term "non-threaded" in the claims to describe the positioning member. The specification never uses the term "non-threaded," and it makes absolutely no comment as to what the scope of this term would be. Therefore, one can not determine precisely what a "non-threaded positioning member" would be.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 64, 65, 67, 70, 71, 73, 76, 78, 79, 81, 83, 84, 86, 88, 90 rejected under 35

U.S.C. 102(b) as being anticipated by Livick. Note the door lock drilling template having first flange 10 and second perpendicular flange 14, 30. Positioning member 22 has a hole 24, and the positioning member has pins may selectively be placed on holes 20 in order to move the hole 24 laterally from a first position to a second position. Regarding claim 76, as seen from figure 5, the positioning member 22 will prevent flange 10 from contacting the face of the door. Note drilling tool 26.

6. Claims 64, 65, 67, 70, 71, 73, 77, 78, 79, 81, 83, 84, 86, and 90 are rejected under 35

U.S.C. 102(b) as being anticipated by Shouse. Figures 1-3 show a door template having a first flange 2 and a second perpendicular flange 3. As seen in figure 3, flange 2 has two laterally offset openings 5 and 6 of identical size. Positioning members 8 and 9 have drill guide holes 12 in them (see column 4, lines 5-11), such that either member 8, 9, will fit in either opening 5 or 6. Depending on the desired location of the drilled holes, the positioning member may be selectively placed in either opening 5 or 6 (which constitute first and second positions).

7. Claims 64-90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each of claims 68, 74, 82, and 87 state that the positioning member is “unattached” to the first flange. As stated at page 8, lines 23-24, of the specification, the tabs 60 are “flexibly attached” to the frame (and flange 14) by a flexible strap 70. Therefore, each of these claims incorrectly state that the positioning members are “unattached” to the first flange.

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Claim 77 depends from itself. It will be treated as if it depends from claim 70. The meaning of the term “non-threaded” throughout the claims is unclear.

8. On line 3 of claims 76, 77, 88, and 89, “is” should be inserted after “member.”

9. Claims 64-89 are rejected under 35 U.S.C. 102(b) as being anticipated by Matadobra.

Template 10 has a first flange 24 for abutting against the door edge and a second flange 21 having openings 15, 16. As discussed at column 3, lines 35+, placing the positioning member 27 between flange 24 and the door edge will shift the position of the openings 15, 16. The screws shown in figure 2 permit the positioning member to be “removably mountable” on the first flange 24. The condition when the positioning member 27 is attached to flange 24 is considered to be a first position, and the condition when member 27 is unattached to the flange 24 is considered to be the second position.

10. Claims 64, 65, 67, 70, 71, 73, 77, 78, 79, 80, 83, 84, 85, and 90 are rejected under 35 U.S.C. 102(b) as being anticipated by Roberts. Roberts shows a first flange 6 and a second flange 1. Positioning member 10 having opening/drill guide 16 is laterally movable along slot 9 to position the opening 16 along second flange 1 between a first position and a second position.

11. In view of the 112 issues discussed above, the examiner will not make any more rejections under 35 USC 102 in this current Office action. Applicant is strongly urged to carefully review the other references cited by the examiner, as some of those references are also quite good.

12. The use of the trademark LEXAN™ has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

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Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

13. Ignoring for a moment any complications which might be caused by dependent claims, the examiner will provide a way that independent claim 70 may be amended to put it in condition for allowance. If **all** of these changes are made, then claim 70 would be allowed:

A lockset drilling guide system comprising:

a door comprising a first planar face and a second planar face that is perpendicular to said first planar face;

a frame defining an opening in said frame, said frame comprising a first flange that lies adjacent to and parallel to said first face of said door and a second flange mounted perpendicularly thereto and lying adjacent to and parallel to said second face, said opening being on said second flange; and

a [non-threaded] positioning member [removably mountable] attached on said first flange by a flexible piece, said positioning member being movable from a first position located between the first flange and the first face of said door to a second position not between the first flange and first face of said door [with respect to said frame];

wherein said positioning member laterally displaces said opening on said second face when said positioning member is moved from said first position to said second position.

14. Any inquiry concerning the content of this communication from the examiner should be directed to Daniel Howell, whose telephone number is 703-308-1728. The examiner's office hours are typically about 10 am until 6:30 pm, Monday through Friday. The examiner's supervisor, Andrea Wellington, may be reached at 703-308-2159.

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Any inquiries concerning other than the content of this and previous communications, such as missing references or filed papers not acknowledged, should be directed to the Customer Service Center for Tech Center 3700 at 703-306-5648.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at FAX number 703-872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Daniel Howell of Art Unit 3722 at the top of your cover sheet.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is 703-308-1148.

A handwritten signature in black ink, appearing to read "Howell", with a stylized flourish at the end.

Daniel W. Howell  
Primary Examiner  
Art Unit 3722